

# Notice of Allowability

Application No.

10/713,163

Examiner

Michael J. Feely

Applicant(s)

SHIOBARA ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment and TD filed April 12, 2006.
2. ☒ The allowed claim(s) is/are 1-8.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

Michael J. Feely  
Primary Examiner  
Art Unit: 1712

## **DETAILED ACTION**

### ***Previous Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Honda et al. (Pub. No.: US 2001/0031828) or Honda et al. (US Pat. No. 6,645,632) in view of Oka et al. (US Pat. No. 6,268,033) has been overcome by amendment.
3. The rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Honda et al. (Pub. No.: US 2001/0031828)/Honda et al. (US Pat. No. 6,645,632) and Oka et al. (US Pat. No. 6,268,033) in view of Inoue et al. (US Pat. No. 5,728,473).

### ***Terminal Disclaimer***

4. The terminal disclaimer filed on April 12, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat. No. 6,949,619 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Previous Double Patenting***

5. The rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 5 of Honda et al. (US Pat. No. 6,645,632) in view of Oka et al. (US Pat. No. 6,268,033) has been overcome by amendment.
6. The rejection of claim 3 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 5 of Honda et al. (US Pat. No. 6,645,632) in view of Oka et al. (US Pat. No. 6,268,033) and Inoue et al. (US Pat. No. 5,728,473) has been overcome by amendment.

Art Unit: 1712

7. The rejection of claims 1 and 2 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-6 and 9 of Ichiroku et al. (US Pat. No. 6,949,619) in view of Oka et al. (US Pat. No. 6,268,033) has been overcome by the timely filed terminal disclaimer.

8. The rejection of claim 3 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-6 and 9 of Ichiroku et al. (US Pat. No. 6,949,619) in view of Oka et al. (US Pat. No. 6,268,033) and Inoue et al. (US Pat. No. 5,728,473) has been overcome by the timely filed terminal disclaimer.

***Allowable Subject Matter***

9. Claims 1-8 are allowed.

10. The following is an examiner's statement of reasons for allowance: Applicant has successfully amended the instant invention to overcome the prior art.

Honda et al. (Pub. No.: US 2001/0031828)/Honda et al. (US Pat. No. 6,645,632) disclose a similar adhesive; however, the polyimide used in Honda et al. does not read on the polyimides set forth in the instant invention.

- *With respect to the embodiment featuring polyimide (1):* the phenolic hydroxyl radical present in Honda et al. (see: paragraph 0011; column 2, line 65 through column 3, line 16) does not correspond with the phenolic hydroxyl radical used in the instant invention (see Y<sub>1</sub> & B).
- *With respect to the embodiment featuring polyimide (2):* Honda et al. fail to teach or suggest a polyimide bearing phenolic hydroxyl radical at both terminals.

Art Unit: 1712

The teachings of Ichiroku et al. (US Pat. No. 6,949,619) overlap the scope of the instant invention; however, the reference does not qualify as prior art. The inventive entity in the reference is that same as the inventive of the instant invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Art Unit: 1712

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely  
Primary Examiner  
Art Unit 1712

April 27, 2006

**MICHAEL FEELY  
PRIMARY EXAMINER**